

REMARKS

Reconsideration of the rejections set forth in the Office Action is respectfully requested. By this amendment, claims 1 and 12 have been amended. Currently, claims 1-12 are pending in this application.

Specification

The Examiner requested that the specification be updated to provide the patent number of the related application cited on page one of the specification. Applicants have amended the specification as requested by the Examiner

Rejection under 35 U.S.C. 102(e)

Claims 1, 3-7, 9, and 12 were rejected under 35 U.S.C. 102(e) as anticipated by Moshfeghi (U.S. Patent No. 6,216,104). This rejection is respectfully traversed in view of the amendments to the claims and the following arguments.

This application relates to a way of enabling computer telephony resources to be made available over a network. As described on pages 1-2 of the application, there are many types of network devices that provide specific functionality in a communications network. It has conventionally been difficult to integrate these network devices and services because of the proprietary protocols utilized by the network devices. One goal of the instant application was to provide a framework for developing computer telephony applications by enabling these diverse network devices to be interoperable. The solution, according to an embodiment of the invention, was to utilize an object-oriented, language independent, architecture, such as a CORBA bus, to allow the computer telephony resources to be utilized together.

Moshfeghi teaches a computer based patient record management system which allows a client computer 12 to access patient records from one or more databases. (Col. 3, lines 3-9). A CORBA server interconnects a client computer 12 with the patient record information (34, 36), (col. 4, lines 37-58) which may be customized by the user. One aspect of customizing the user's interaction with the patient record management system is that the user is allowed to generate reminders or other alerts to be generated automatically by the system and output over a pager system 52, e-mail system 52, or voice mail facility 56. (Col. 5, lines 17-32).

The resources that are controllable by the client 12 in Moshfeghi are database resources 34, 36. The client cannot directly access the e-mail system, pager system, or voice-mail facility. Instead, the client 12 accesses the databases, which generate reminders/notifications, that are then output by the system via the alert/reminder output devices system 51.

Thus, Moshfeghi does not teach or suggest a method or apparatus which enables a client to access or control telephony or media resources over a CORBA server. Instead, Moshfeghi teaches that the CORBA bus should be used to interface databases with a client system. The system is designed to handle patient records. The only incidental nexus with telephony systems is that reminders, generated by the patient record system, are made available through a pager system, e-mail system and voice-mail facility.

Claim 1 has been amended to recite that a server includes an interface to a data network, an interface to a computer telephony resource providing a computer telephony service, and means for receiving a first request... for access to the computer telephony resource. The term computer telephony is discussed, for example, at page 1, lines 15-16.

Since the server 14 in Moshfeghi does not receive requests for access to computer telephony resources from the client, applicant respectfully requests that the rejection of independent claim 1 be withdrawn. Claim 12 has been amended in a similar fashion and is not anticipated by Moshfeghi for the same reasons.

Rejection under 35 U.S.C. 103

Claims 2, 8, 10, and 11 were rejected under 35 U.S.C. 103 as unpatentable over Moshfeghi in view of Jordan (U.S. Patent No. 6,163,535). This rejection is respectfully traversed in view of the following arguments.

The Examiner has acknowledged that Moshfeghi does not disclose a telephony subsystem in detail. The Examiner has taken the position that Jordan discloses a voice processing subsystem in a conventional telephone network, and contends that it would have been obvious to combine the features of the two references.

Jordan teaches a voice processing unit for interfacing with telephone lines on a telephone network. Each voice processing unit has one or more line interface units 52, a call manager component 62, a TDM bus 54, voice resources 55 such as an interactive voice response unit, and an adapter card. The local call manager 62 controls access to the TDM bus. (Col. 7, lines 56-65). The central call manager controls which VPU should handle a particular call. (Col. 10, lines 30-32). The local and central call managers communicate via CORBA. (Col. 7, lines 48-53). Upon receipt of a determination as to which VRU should handle a particular call, the ATM switch and ATM adaptor card handle retrieving the call from the TDM bus, transferring the call to another line interface unit 52, and placing the call on the TDM bus of the second line interface unit.

Jordan, therefore, fails to teach or suggest means for receiving a first request containing an object-oriented, language independent, second request for access to a telephony resource. Specifically, although Jordan does teach a first request containing an object-oriented, language independent, second request, the second request is not a request for access to a telephony resource. Rather, the request in Jordan is a request for an indication as to what line interface unit should handle the call. Accordingly, neither Jordan nor Moshfeghi teach or suggest a system in which a request is made over a CORBA bus to access a telephony resource.

However, even if the Examiner is correct that Jordan teaches telephony subsystems, combining Moshfeghi and Jordan would not result in the invention as claimed. Specifically, since Moshfeghi only controls databases using the CORBA bus, but does not control the alert/reminder output devices themselves, adding additional telephony subsystems to the alert/reminder output devices system would not enable those additional telephony subsystems to be controlled by the CORBA server 14.

Moreover, a person of ordinary skill in the art would not have looked to combine Moshfeghi and Jordan since there is no reason of record why a patient record system that enables doctors or other authorized persons to obtain patient records should be used to control telephony systems such as routers and signaling system servers. Likewise, there is no reason of record why a person of skill in the art would have looked to combine Jordan, which describes a distributed voice processing system with the patient record system of Moshfeghi.

The Examiner has not taken the position that there is any teaching in the references themselves that these two references should be combined. Rather, the

Examiner has taken the position that the motivation stems from the result of the combination: "it would have been obvious... to utilize Jordan telephony subsystems in Moshfeghi because it would have allowed the middleware server to directly communicate with the voice processing components (e.g., using CORBA)."

Applicants respectfully submit that this statement is insufficient to establish that the claims are *prima facie* obvious. Specifically, to establish that the claims are obvious, the Examiner must point to "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Manual of Patent Examining Procedure (MPEP) @ 2142, p. 2100-121 (August 2001), see also MPEP @ 2143.01, p.2100-123.

The Examiner has not pointed out where Moshfeghi or Jordan suggest the combination, or how knowledge generally available would suggest the combination. Rather, the Examiner has simply stated the result of the combination as the motivation for making the combination in the first instance. This is clearly improper.

To establish, *prima facie*, that the claims are obvious, the Examiner must substantiate the alleged motivation with objective evidence. In re Lee, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.") (emphasis added). Additionally, the law is clear that the mere citation of a result stemming from a combination does not constitute evidence. See In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear

that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Id.

Merely stating that it is obvious to combine references does not, by itself, make it so. Here, the Examiner did not provide any evidence as to the motivation for making the proposed combination, but simply stated that the combination would have allowed the middleware server to directly communicate with the voice processing components. Since this merely states the result of the combination as the motivation for the combination, this statement does not constitute objective evidence of a motivation to combine the references in the first instance. Thus, applicants respectfully submit that the Examiner has failed to establish that the claims are *prima facie* obvious.

One way of looking at the issue, is that the result of the combination did not exist until the Examiner proposed making the combination. Therefore the result of the combination, without more, cannot be the genesis for the combination -- there must be some motivation to seek the result or to look for the combination. Note that, as provided by the MPEP, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP @ 2143.01, p. 2100-124 (emphasis in original). The art cited by the examiner in this instance certainly does not suggest the desirability of the

combination, since the two references come from unrelated areas of technology, and neither reference attempts to solve the problem faced by the applicant.

Since the Examiner failed to present any objective evidence of motivation to combine the references, applicant respectfully submits that the Examiner failed to establish that the claims are *prima facie* obvious, and respectfully requests that the rejection of the claims under 35 U.S.C. 103 be withdrawn.

Request for Interview

If the Examiner believes that continued rejection of the claims is warranted, after reviewing the arguments presented herein, applicant respectfully requests that the Examiner contact the applicant's representative at the number below to schedule a telephone interview to discuss this application. If possible, applicants would like to conduct the interview prior to entry of the next Official Action.

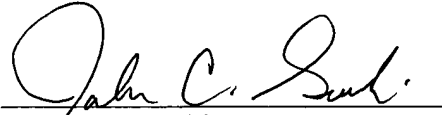
Conclusion

In view of foregoing claim amendments and remarks, it is respectfully submitted that the application is now in condition for allowance and an action to this effect is respectfully requested. If there are any questions or concerns regarding the amendments or these remarks, the Examiner is requested to telephone the undersigned at the telephone number listed below.

Amendment Dated May 29, 2003
Serial No. 09/223,972

If any fees are due in connection with this filing, the Commissioner is hereby authorized to charge payment of the fees associated with this communication or credit any overpayment to Deposit Account No. 502246 (Ref: NN-HU0125).

Respectfully Submitted

A handwritten signature in black ink, appearing to read "John C. Gorecki", written over a horizontal line.

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